

## **REMARKS/ARGUMENTS**

The Applicant has carefully considered this application in connection with the Examiner's Action and respectfully requests reconsideration of this application in view of the foregoing amendments and the following remarks.

The Applicant originally submitted Claims 1-36 in the application. The Applicant has not amended, canceled or added any claims. Accordingly, Claims 1-36 are currently pending in the application.

### **I. Rejection of Claims 1-36 under 35 U.S.C. §112**

The Examiner rejected Claims 1-36 under 35 U.S.C. §112 as having a presentation that is unclear. The Examiner stated that the criteria followed by the Examiner in determining that the presentation was unclear is based on how one of "ordinary skill in the art" would perceive the presentation. The Examiner states that there are multiple independent/claims sets and that the dependent claims are presented in permutation. (Office Action, page 5). The Examiner makes this statement, but does not give any example to support it. There are three independent claims with multiple dependent claims, but nothing that is a person of ordinary skill in the art would have difficulty in understanding. Thus Applicant respectfully disagrees with the Examiner's statement that the presentation is unclear. Although the presentation is technical, the substance of the invention is understood by the undersigned, clearly a person of less than ordinary skill in the art. It is difficult to respond to the Examiner's broad statement that the presentation is unclear without being directed to specific examples. Is the presentation unclear or are is the claim language unclear? Is the Examiner having difficulty in finding support for the claims in the disclosure?

It should be noted that the Applicant has made presentations to audiences regarding the substance where there were presumably parties skilled in the art present. In no instance did Applicant have any party state that he or she did not understand the invention. Nevertheless, in an effort to make the presentation more clear, the Applicant undertook a detailed review of the Application and is herein amending the specification to correct any grammatical and typographical errors that were discovered. Inasmuch as it appears that a fundamental communication problem may exist, the Applicant respectfully requests a conference to further clarify this matter if the Examiner persists in his position.

The Applicant also noted that attached to the Office Action was an IDS filed in connection with an unrelated application (Application No. 10/00264) where an unrelated party was listed by the Examiner as the first named inventor. In fact, as noted below, one of the cases in this IDS (Schuth, figure 2) was cited by the Examiner as a reference for disallowing the Applicant's claims herein. Nonetheless, the Applicant believes the text of the Office Action was directed to his invention and has responded accordingly.

## **II. Rejection of Claims 1-36 under 35 U.S.C. §102**

The Examiner rejected Claims 1-36 under 35 U.S.C. §102 as anticipated by U.S. Patent Application US2002/0017617 A1, by Schuth, *et al.* (Schuth), U.S. Patent No. 6,121,892 to Reindl, *et al.* (Reindl) and Skeie. In the IDS filed by the Applicant, two patents were listed naming Skeie as a first named inventor. The Applicant is not certain which of these two patents is being cited by the Examiner as an anticipating reference. The two patents listed by Applicant in the IDS are U.S. Patent No. 4,625,208 to Skeie, *et al.* (Skeie 208), and U.S. Patent No. 4,737,790 to Skeie, *et al.*

(Skeie 790). Inasmuch as both Skeie 208 and Skeie 790 address SAW devices, the Applicant will address both in view of the present invention.

As the Examiner is no doubt aware, anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference; the disclosed elements must either be disclosed expressly or inherently and must be arranged as in the rejected claims. Schuth addresses a method for the combinatorial preparation of material libraries and testing the same and an apparatus for carrying out this process. (Para. 0001). Schuth does not address SAW devices and most definitely does not address a SAW tag with a group of slots on a substrate arranged by both pulse position and by phase position where a number of reflectors distributed among the slots encode a number by both pulse position and phase position. Thus, Schuth does not disclose each and every element of the claimed invention and as such, is not an anticipating reference for Claims 1-36. Accordingly, the Applicant respectfully requests the Examiner to withdraw the §102 rejection with respect to these claims.

Reindl describes a SAW device that uses a diverter to acoustically couple reflectors with the objective being to increase the amount of data that can be encoded on a piezoelectric substrate. Reindl describes a SAW device in which response signals are encoded by either phase angle or by the position of the reflector on the substrate, but not both at the same time. In short, Reindl does not describe a device where reflectors are distributed on a substrate so that a reflected signal has encoded therein a number both by pulse position and by phase position. Thus, Reindl does not disclose each and every element of the claimed invention and, as such, is not an anticipating reference for Claims 1-36. Accordingly, the Applicant respectfully requests the Examiner to withdraw the §102 rejection with respect to these claims.

Skeie 208 describes a passive transponder utilizing a SAW device. The device has a substrate defining a path of travel for a SAW; at least one transducer element for converting between electrical energy and SAW energy which propagates along the path of travel; and a circuit, connected to the transducer, for supplying interrogating signals and for receiving reply signals therefrom. Reflectors are provided to reflect the SAW back towards the transducer. (Abstract). The reflectors are arranged to respond to an interrogation pulse with a particular time delay. (Col. 1, lines 60-65). Skeie 208 thus describes a SAW device in which response signals are encoded by the time delay position of a reflector on a substrate. Skeie 208 does not describe a device where reflectors are distributed on a substrate to provide for a reflected signal with a number encoded therein based on both pulse position and phase position of the reflectors. Thus, Skeie 208 does not disclose each and every element of the claimed invention and, as such, is not an anticipating reference for Claims 1-36. Accordingly, the Applicant respectfully requests the Examiner to withdraw the §102 rejection with respect to these claims.

Skeie 790 describes a “passive interrogator label system” where SAW transponders receive an interrogation signal, process the signal and transmit a reply signal, derived from the interrogation signal, containing encoded information. (Abstract). The SAW device in Skeie 790 provides for “signal conditioning elements” that provides a signal having a known delay and a known amplitude modulation of the interrogation signal. (Col. 2, lines 11-16). Skeie 790 does not describe a device where reflectors or “signal conditioning elements” are distributed on a substrate to provide a reflected signal with a number encoded therein based on both pulse position and phase position. Thus, Skeie 790 does not disclose each and every element of the claimed invention and,

as such, is not an anticipating reference for Claims 1-36. Accordingly, the Applicant respectfully requests the Examiner to withdraw the §102 rejection with respect to these claims.

### **III. Rejection of Claims 1-36 under 35 U.S.C. §103**

The Examiner also apparently rejected Claims 1-36 under 35 U.S.C. §103 as unpatentable over Schuth, Reindl and Skeie. As the Examiner is no doubt aware, determination of obviousness requires consideration of the invention considered as a whole; the inquiry is not whether each element exists in the prior art, but whether the prior art made obvious the invention as a whole. Furthermore, there must be some suggestion or teaching in the art that would motivate one of ordinary skill in the art to arrive at the claimed invention; a reference that teaches away from a claimed invention strongly indicates nonobviousness.

As described above, Schuth, Reindl and Skei do not describe nor suggest that a SAW tag with a group of slots on a substrate can be arranged by both pulse position and by phase position so that reflectors distributed among the slots to encode a number by both pulse position and by phase position at the same time. Thus, Schuth, Reindl and Skei, individually or in combination with each other, fail to teach or suggest the invention recited in Claims 1-36, when considered as a whole. The Applicant therefore respectfully requests the Examiner to withdraw the rejection.

#### **IV. Conclusion**

In view of the foregoing amendment and remarks, the Applicant now sees the claims currently pending in this application to be in condition for allowance and therefore earnestly solicits a Notice of Allowance for Claims 1-36.

The Applicant requests the Examiner to telephone the undersigned attorney of record at (972) 480-8800 if such would further or expedite the prosecution of the present application. The Applicant most earnestly requests a conference to discuss the application should the Examiner not allow the pending claims.

Respectfully submitted,

HITT GAINES, P.C.

A handwritten signature in cursive script, appearing to read "Jimmy L. Heisz".

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